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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,431	07/18/2003	Jay D. Kranzler	CYPR 100 CIP CON	4067

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EXAMINER	
HUGHES, ALICIA R	

ART UNIT	PAPER NUMBER
1614	

MAIL DATE	DELIVERY MODE
09/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/623,431	KRANZLER ET AL.	
	Examiner	Art Unit	
	ALICIA R. HUGHES	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *99-128* is/are pending in the application.

4a) Of the above claim(s) *100, 102-108, 110, 112-118, 120 and 122-128* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *99,101,109,111,119 and 121* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims and Examination

Applicants cancelled claims 76-82, 84-88, and 90-98 on 14 December 2007 while concurrently adding new claims 99-128, which are now pending. Claims 99, 101, 109, 111, 119 and 121 are the subject of this Office Action.

Applicants' arguments filed on 14 December 2007 and 04 June 2008 have been fully considered but are deemed to be persuasive regarding the previous rejection. Rejections not reiterated from this Office's previous action are hereby withdrawn. The rejections set forth herein constitute the complete set of rejections being applied to the instant application presently.

Election/Restriction Requirement

Claims 100, 102-108, 110, 112-118, 120 and 122-128 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04 June 2008. The Office required an election in its Action of 16 May 2008, of which Applicants chose the combination of milnacipran and pregabalin.

Applicant's election with traverse of milnacipran in combination with pregabalin to treat pain, fibromyalgia and chronic fatigue syndrome in the reply filed on 04 June 2008 is acknowledged. The traversal is on the ground(s) that full examination of all claims in the application would not pose a serious burden on the Examiner. This is not found persuasive because as noted prior, present claims 99, 109, and 119, for example, each provide 10

possibilities for drugs to be used in combination with milnacipran for the treatment of three different diseases or disorders. For hypothetical explanation purposes, if this application were examined as presented, thirty different searches would be required, as a search for one of the aforementioned compounds does not necessarily disclose results for another. For example, the field of search for pramipexole will not necessarily yield results for clonidine, *per se*, as clonidine is known to be useful in the treatment of hypertension whereas pramipexole is known to be useful in the treatment of Parkinsons disease and depression. Please see U.S. Patent Pre-Grant Publication No. 2004/0063628 ["Piccariello et al"](Paragraphs 744, 1873, 1857, etc).

Thus, a majority of the combinations encompassed by the present claims have acquired a separate status in the art. Notwithstanding that the classification of some of the active agents is co-extensive, all of the claimed compounds are patently distinct, and they fully capable of supporting separate patents.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 99, 101, 109, 111, 119 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,441,038 [hereinafter referred to as "Loder et al"] in view of U.S. Patent No. 6,500,853 B1 [hereinafter referred to as "Seehra et al"].

Loder et al teach that chronic fatigue syndrome, fibromyalgia and perceptive pain associated therewith and depressed mood as known disorders of neurological orgin treatable with a drug that "is a compound which inhibits both noradrenaline and serotonin reuptake" (Col. 9, lines 7-9) and more specifically, milnacipran accompanied by either L-phenylalanine or tyrosine (Col. 9, lines 17-32, claims 1-4).

Seehra et al teach the administration of pregabalin as effective in the treatment of pain, fibromyalgia and chronic fatigue syndrome (Col. 101, lines 23-25; Col. 104, lines 8-10), and that it can be used in combination with other drugs effective in treatment of the same (Col. 102, lines 37-48).

Finally, as a matter of law, combining compounds known to individually treat a known disease or disorder would obviously treat the same disease/disorder when combined. *See In re Kerkhoven*. Therefore, the combination of an effective amount of milnacipran with pregabalin to treat pain, fibromyalgia and chronic fatigue syndrome, for example, would have a reasonable expectation of success.

Further, one of ordinary skill in the art would have been motivated to combine the teachings of Loder et al with the teachings of Seehra et al, because both are directed to the

treatment of pain, fibromyalgia and chronic fatigue syndrome and further, the Seehra et al reference does allude to the effectiveness of combination treatments for these conditions.

In light of the foregoing, it would have been *prima facie* obvious to, upon determining the effectiveness of milnacripran and pregabalin to administer the same in combination with each other, to treat pain, fibromyalgia and chronic fatigue syndrome at the time that the instant invention was made.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The examiner can normally be reached from 9:00 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Public PAIR only. For information about the PAIR system, see http://pair-direct-uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia R. Hughes/

Examiner, Art Unit 1614

/Raymond J Henley III/
Primary Examiner, Art Unit 1614